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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,047	05/09/2001	UmaShanker Sampath	1252/1G348US1	5094

7278 7590 10/10/2002

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EXAMINER
YOUNG, JOSEPHINE

ART UNIT	PAPER NUMBER
1623	6

DATE MAILED: 10/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/853,047	Applicant(s) SAMPATH ET AL.	
	Examiner Josephine Young	Art Unit 1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-31* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-9, 13-20, drawn to heteropolymeric compounds, classified in class 536, subclass 22.1.

II. Claim 10, drawn to methods for treating viral infection, classified in class 514, subclass 44^{+}.

III. Claim 11, drawn to methods for treating cancer, classified in class 514, subclass 44^{+}.

IV. Claim 12, drawn to methods for treating microbial infections, classified in class 514, subclass 44^{+}.

V. Claims 21-27, drawn to pyrimidine nucleoside derivatives, classified in class 536, subclass 28.5.

VI. Claims 28-31, drawn to deoxyribose derivatives, classified in class 536, subclass 17.1.

The inventions are distinct, each from the other because of the following reasons:

Groups I, V and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, each of the different Groups I, V and VI is patentably distinct from the other because they are directed to

compounds which contain different functional groups. The compounds of Group I are heteropolymeric comprising a chain of nucleoside, nucleoside analogs, abasic nucleosides or heterocyclic derivatives. The compounds of Group V are pyrimidine nucleoside analogs. The compounds of Group VI are deoxyribose derivates. The functional groups of one do not render obvious the functional groups of another.

Group I is related to each of Groups II, III and IV as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product of Group I can be used in materially different processes, e.g. the process of Group II, III or IV. Each of the products of Group V and VI is unrelated to each of the methods of Groups II, III and IV, because each method does not require either of these products.

Groups II, III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to the method of treating patentably distinct diseases in a patient. The method of Group II is directed to the treatment of a viral infection. The method of Group III is directed to the treatment of cancer. The method of Group IV is directed to the treatment of cancer. The treatment of viral infection does not render obvious the treatment of cancer or a microbial infection, and vice versa.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their recognized divergent subject matter, restriction for examination purposes as indicated is proper. Searches for the six groups would not be co-extensive, and therefore place an undue burden on the Examiner. A reference for one group could not reasonably be expected to be a reference for another group. Further, though some of the Groups are classified in the same class and sub-class, searching all the inventions constitutes a burdensome search, as a thorough search comprises a search of foreign patents and non-patent literature, as well as the appropriate U.S. patent classifications. To search the six independent and distinct inventions, set forth supra, would indeed impose an undue burden upon the examiner in charge of this application.

Group I of this application contains claims directed to the following patentably distinct species of the claimed invention: heteropolymeric compounds comprising a chain of nucleosides, nucleoside analogs, abasic nucleosides or heterocyclic derivatives including heteropolymeric compounds wherein (a) R^1 is not present; (b) R^1 is a pharmaceutically active nucleoside or nucleoside analog, or (c) R^1 is a heterocyclic derivative.

If Group I is elected, Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-6 and 13-20 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Josephine Young whose telephone number is (703) 605-1201. The examiner can normally be reached on Monday through Friday, 9:00 a.m. to 6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached at (703) 308-4624. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

JY
October 8, 2002

KATHLEEN K. FONDA
PRIMARY EXAMINER